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OFFICE OF PETITIONS

In re Application of
Barton, et al.
Application No. 07/827,906
Filing Date: 30 January, 1992
Attorney Docket No.: 1122990199

DECISION

This is a decision on the petition filed on 21 November, 2007, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It appears that Petitioner has satisfied the requirements of the regulation, as set forth below:

BACKGROUND

The record reflects that:

Petitioner failed to reply timely and properly to the Decision of the Board of Patent Appeals and Interferences (BPAI) mailed on 29 January, 2004, with reply due under the provisions of 35 U.S.C. §142 (or see also: MPEP §1214.07). (The original petition referred generally to certain post-BPAI decision events, but presents no specification as to dates and transactions with copies of date-stamped documents in support of such calendar of event, nor does Petitioner provide any statement and supporting documentation evidencing compliance with 37 C.F.R. §41.205.)

It appears that the application went abandoned by operation of law after midnight 29 March, 2004, however, as indicated above, in the absence of statements and documents there was no clear evidence in this regard at the time of consideration of the earlier petition.

The Office mailed the Notice of Abandonment on 8 May, 2006.

The original petition, filed with fee as indicated above on 27 July, 2006, and a preliminary amendment as the reply under 37 C.F.R. §1.129 and a terminal disclaimer and fee, referred to events without specificity/documentation supporting the statements—and so the petition was dismissed on 27 August, 2007, and Petitioner was requested to provide from the proper representative (assignee with supporting certificate) the statement of unintentional delay with documentary support for the averment that the entire delay from the due date of the reply (i.e., date of abandonment by operation of law until the filing of a grantable petition was unintentional (see: MPEP §711.03(c)), as well as a proper revocation/power of attorney with certificate pursuant to 37 C.F.R. §3.73(b)—these latter documents now have been provided—in compliance with the Rules of Practice.

On 21 November, 2007, Petitioner filed the instant petition (with fee) alleging unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of an amendment, and made the statement of unintentional delay.

The record (including the petitions filed on 27 July, 2006, and 21 November, 2007) does not necessitate a finding that the delay between midnight 29 March, 2004 (the date of abandonment), and 27 July, 2006, and 21 November, 2007 (the date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner though its officer Lawrence M. Lavin, Jr., and Counsel David A. Gass (Reg. No. 38,153) when accepting Petitioners' representation that the delay in filing the response was unintentional.

The terminal disclaimer filed on 21 November, 2007, under 37 C.F.R. §1.137(d) has been entered and made of record.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.^{2, 3}

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center/AU 1638 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center/AU OPAP where that change of status must be effected—that does not occur in the Office of Petitions.

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

² See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

³ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a). And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



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⁴ The regulations at 37 C.F.R. §1.2 provide:
§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.